

REMARKS

The Office action summary page states that all of the pending claims, claims 89-156, are rejected. The text of the rejection, pages 3-5, states that claims 89-148 and 154-156 are rejected for obviousness over a previously cited reference, Stylli. At the outset, applicants note that it is unclear, given the discrepancy between the text and the summary page, whether claims 149-153 are allowable.

Rejection under 35 U.S.C. § 103(a)

The rejection of the claims for obviousness over Stylli is traversed.

As was explained in the reply to the previous Office action, the inventors were the first to conceive a fundamentally new idea, which is not disclosed or hinted at by Stylli: the inventors provided a powerful new method for identifying new therapeutics by screening large number of combinations of compounds for those few that exhibit a desirable activity, such as anti-tumor activity.

The cited reference, Stylli, describes a system for screening individual compounds for a particular activity. As the examiner has previously admitted, and admits again in the present Office action, Stylli does not teach or suggest what all of the present claims require: screening two-compound or higher order combinations of compounds for a desirable biological property.

Despite the manifest failure of Stylli to suggest the new concept memorialized in

the present claims, the examiner rejects the claims for obviousness over Stylli because the new concept, in the examiner's view, is "merely a choice of experimental design," citing *In re Aller*.

With all due respect, applicants read the present Office action with surprise and dismay.

First, there are 62 pending claims. All of the claims were rejected with a few sweeping statements, with none of the limitations in any of the claims having been addressed.

More fundamentally, the brief analysis which the Office action did provide is totally without basis in fact, and grossly misinterprets the law.

The M.P.E.P. states: "Official notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known, or to be common knowledge in the art or capable of instant and unquestionable demonstration as being well-known." (sic) That section of the M.P.E.P. further states that "to traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." The applicant must also demand, under these circumstances, that the examiner produce authority for the statement made in the Office action.

Applicants hereby demand that the Examiner produce authority for the statement

that a conceptually new, multi-compound screening method is a "choice of experimental design" or "optimum or workable range" compared to Stylli, which does not hint at the claimed inventive concept, and only screens single compounds. Applicants also demand that the Examiner cite authority for the proposition that the Stylli methods "would need no modification other than increasing the amount of compound combinations that do not materially affect the method steps." Stylli, as acknowledged earlier in the Office action, does not test any compound combinations, and thus the above-quoted passage from the Office action is not understood by applicants.

Applicants now turn to the *Aller* case, which is cited in support of the obviousness rejection. Before discussing the facts, applicants note the statement in the M.P.E.P. §2144.04: "if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court." *Aller* has absolutely no applicability in the present case. In *Aller*, the prior art "referenced process...differed from the claims only in that the referenced process was performed at a temperature of 100° C and adds a concentration of 10%" as compared to the claimed process, "which was performed between 40° and 80° C and adds a concentration between 25% and 70%."

Aller is one of several cases cited in the M.P.E.P. for the proposition that mere optimization is not sufficient for patentability. It is manifestly clear that the present invention has nothing to do with the method of Stylli. Rather, the claims are directed to

completely conceptionally new methods, not hinted at in Stylli. The facts of the present case and the facts in *Aller* could not be more different.

CONCLUSION

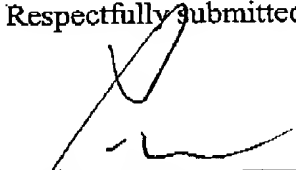
The Office action presents an obviousness rejection which has no basis in fact or law. It should be withdrawn. The claims are in condition for allowance.

Applicants request review of this case by the Supervisory Patent Examiner, Mr.

Andrew J. Wang.

Respectfully submitted,

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Paul T. Clark
Reg. No. 30,162

Clark & Elbing LLP
101 Federal Street
Boston, MA 02110
Telephone: 617-428-0200
Facsimile: 617-428-7045